

Remarks

Claims 12-14 and 23 are currently pending and being considered in the present application after the addition of new claim 23. Claim 12 has been amended.

Claims 12 to 14 were rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 6,122,588 to Shehan et al. ("Shehan"). Withdrawal of the rejection is requested in view of the following explanation.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, the Examiner must show, *inter alia*, that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references, and that, when so modified or combined, the prior art teaches or suggests all of the claim limitations. M.P.E.P. §2143. In addition, as clearly indicated by the Supreme Court, it is "important to identify a reason that would have prompted a person of ordinary skill in the relevant field to [modify] the [prior art] elements" in the manner claimed. See KSR Int'l Co. v. Teleflex, Inc., 82 U.S.P.Q.2d 1385 (2007). In this regard, the Supreme Court further noted that "rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." Id., at 1396. To the extent that the Examiner may be relying on the doctrine of inherent disclosure in support of the obviousness rejection, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art." (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

Independent claim 12 has been amended to recite, in relevant parts, "wherein in the case of the actual speed of the vehicle exceeding the predefined setpoint speed, preventing activation of the service brake if the actual speed of the vehicle exceeds the predefined setpoint speed by less than the first predefined speed difference, and wherein the first

predefined speed difference is specified such that the activation of the service brake occurs only when the engine braking action realized by a deceleration fuel-cutoff has already reached a maximum value.” Applicants respectfully submit that these claimed features are not suggested by Shehan, as explained in detail below.

First, to the extent the Examiner summarily concludes (without any supporting rationale of citation) that it would have been obvious to modify the teachings of Shehan to satisfy the claimed limitation of “**preventing action of service break if the actual speed of the vehicle exceeds the predefined setpoint speed by less than the first predefined speed difference,**” this conclusory assertion of the Examiner clearly fails to satisfy the Supreme Court’s guideline that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”

Second, with respect to the claimed limitation of “**wherein the first predefined speed difference is specified such that the activation of the service brake occurs only when the engine braking action realized by a deceleration fuel-cutoff has already reached a maximum value,**” which limitation is clearly described in the Substitute Specification, e.g., p. 12, l. 24-27, there is simply no suggestion of this limitation in Shehan. Applicants will explain the actual teachings of Shehan in detail below.

Shehan discloses a system and a method for reducing the speed of a vehicle in order to maintain a setpoint speed. In order to achieve this, the current vehicle speed is compared to the setpoint speed in order to ascertain a speed deviation. In a preferred specific embodiment of Shehan, controller 12 ascertains the speed deviation, reduces the engine/motor torque, and checks to see whether an additional braking torque is required. (Column 4, lines 25-27). When the speed deviation is within predefined limits, no torque correction is required. (Column 5, lines 5-7). When the current vehicle speed exceeds the desired vehicle speed by a predefined amount, a negative or braking torque is required in order to maintain the speed of the vehicle. (Column 5, lines 19-22). According to column 6, lines 28-34 of Shehan, it is disclosed that when the current vehicle speed exceeds the desired vehicle speed, **the current vehicle speed by is sought to be reduced by** first reducing the

engine torque. Subsequently, a check is carried out to see whether an additional braking torque is required in order to keep the current vehicle speed in a predefined region around the desired vehicle speed. Thus, in Shehan, a check is carried out to see whether the current speed is greater than a desired speed (Fig. 3, block 146). If this is the case, then the engine torque is reduced in block 152. Subsequently, there is a branching to block 154, and a check is carried out to see whether a braking torque is necessary. If yes, then the required braking torque is ascertained in program point 156 and applied in program point 158.

In contrast to the subject matter of amended claim 12, Shehan clearly does not suggest that the first predefined speed difference is predefined such that the service brake is activated only when the engine braking action realized by a deceleration fuel-cutoff has already reached a maximum value. In other words, Shehan does not suggest that the service brake is activated only when the engine braking action of an activated deceleration fuel-cutoff is no longer sufficient because it has already reached a maximum value. In this regard, a deceleration fuel-cutoff may adjust the current vehicle speed to the desired vehicle speed far more effectively than is the case solely by a reduction of the torque requirement in accordance with program point 152 of Figure 3 of Shehan. Thus, when the deceleration fuel-cutoff is used, the use of the activation of the service brake to adjust the current vehicle speed to the setpoint vehicle speed may be delayed even further, so that the service brake may be protected even more, and the adjustment of the current vehicle speed to the setpoint vehicle speed may be realized to an even greater extent by measures implemented solely within the engine.

It is therefore respectfully submitted that Shehan does not describe or suggest the features of independent claim 12. Claims 13-14 and 23 depend from claim 12, and are therefore also allowable.

CONCLUSION

In view of the foregoing, it is respectfully submitted that all of the pending claims are allowable. Prompt reconsideration and allowance of the present application are therefore respectfully requested.

Respectfully submitted,

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